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PTO/SB/21 (08-00)
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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/897,826
Filing Date	3 July 2001
First Named Inventor	Stephen M. REUNING
Group Art Unit	2175
Examiner Name	Samuel RIMELL, Esq.
Total Number of Pages in This Submission	
Attorney Docket Number	Diedre Moire Corp.

ENCLOSURES *(check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment / Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
  - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Assignment Papers *(for an Application)*
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
- ☐ After Allowance Communication to Group
- ☑ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to Group *(Appeal Notice, Brief, Reply Brief)*
- ☐ Proprietary Information
- ☐ Status Letter
- ☐ Other Enclosure(s) *(please identify below)*:

Remarks: Enclosed find a Request for Rehearing under ~~Rule~~ 197(b). No fee is enclosed, because none is believed required.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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Signature	
Date	See below date

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The submitted papers are enumerated on the enclosed Transmittal Form, PTO Form SB/21.

IN THE UNITED STATES PATENT OFFICE

Ex parte Stephen M. REUNING
Serial No. 09/897,826
Filing Date: 03 July 2001

Appeal No.: 2004-1714

Rule 197(b)
REQUEST FOR REHEARING

Honorable Commissioner for Patents
Post Office Box 1450
Mail Stop - Board of Patent Appeals
Alexandria, VA 20231

RULE 197(B) REQUEST FOR REHEARING

This REQUEST FOR REHEARING is submitted in response to the DECISION ON APPEAL (30 Sept 2004). This paper is due within two months of the mailing date of the DECISION ON APPEAL; this paper is thus believed timely filed. No fee is believed required.

GROUNDS UPON WHICH REHEARING IS SOUGHT

Applicant respectfully believes the Board has failed to fully understand the agency's previous administrative fact findings. Applicant senses that this error may simply be due to the Office's failure to forward to the Board the complete prosecution history, including a copy of the parent application file, Serial No. 08/984,650.

The immediate case recites claims copied from the parent application. In the parent case, the Examiner accepted Applicant's RULE 132 DECLARATION to antedate the MCGOVERN reference. In the immediate case, however, the Examiner refuses to accept the same DECLARATION, to antedate the same reference, for the same claims.

POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED

The DECISION ON APPEAL correctly notes that "the claims on appeal are different from the claims allowed in the parent application." *See* DECISION ON APPEAL at 3.

This is incorrect. The claims on appeal are *different* from those recited included in the published issued parent patent. The parent application, however, included additional claims found allowable by the Office. After the Office confirmed the patentability of this subject matter, these claims were deleted from the parent and filed in the immediate case, based on the Examiner's representation that these claims would be promptly allowed.

The DECISION ON APPEAL also misapprehends the content of MCGOVERN, because the DECISION contradicts the agency's administrative factual findings that MCGOVERN fails to each claim element.

The DECISION accurately summarizes the claimed invention as a system for locating an individual with specifically defined professional qualifications. *See* DECISION at 1. The DECISION accurately summarizes the claimed invention:

> 1. A system for locating an individual with specifically defined professional qualifications, the system comprising: a. a filter that can search a web page to identify in said web page the presence or absence of specifically defined professional qualifications, and b. an e-mail address extractor that can extract an e-mail address from said web page.

Thus, application claim 1 entails using specifically defined criteria to filter web pages, and then extracting email addresses from them. The parent application recited similar application claims. For example, parent application claim 18 claims:

> 18. A computer implemented method comprising: a. locating an Internet site page or web posting which contains operator specified text comprising specifically defined experiences ...; b. extracting from said Internet site page or web posting an email address; and c. sending an electronic mail message to said extracted address.

See AMENDMENT IN SERIAL NO. 08/984,650 at 4-5 (15 Feb. 2000). Thus, parent application claim 18, like the immediate application claim 1, entails using specifically defined criteria to filter web pages, and then extracting email addresses from them.[1]

In the parent case, parent application claim 18 was rejected as obvious over MCGOVERN. *See* OFFICE ACTION at 4-6 (1 May 2000).

In response, Applicant submitted a RULE 132 DECLARATION (14 July 2000). In response, the Office withdrew the obviousness rejection over MCGOVERN and conceded that claim 18 is patentable. *See e.g.*, OFFICE ACTION at 2 (24 Aug. 2000).

In response to the 1 May 2000 obviousness rejection over MCGOVERN, Applicant also explained that "McGovern does not disclose a system involving getting an e-mail address – by extraction or otherwise – from an Internet page or web posting; McGovern's e-mail addresses need to be individually sent to or input into the system." *See* AMENDMENT at 6-7 (14 July 2000) (emphasis in original). In response, the Office withdrew the rejection based on MCGOVERN and conceded that claim 18 is patentable. *See e.g.*, OFFICE ACTION at 2 (24 Aug. 2000).

The Office made an express written finding that claim 18 is patentable (in fact, the Office reiterated this finding more than once). The Office has found that "comparing text against professional qualifications and electronically extracting e-mail addresses when those qualifications are met" is a novel, non-obvious combination. Based on the Office's written fact finding, Applicant filed the immediate application. Having made this fact finding, and having represented to Applicant *in writing* that the immediate subject matter is patentable, the Board should not condone the Examiner's arbitrary and capricious change in position.

[1] N.B.: Parent application claim No.18 also includes a third step: sending an email. It might have been argued that this third step differentiates the two claims, making the Applicant's Declaration applicable to one, but not the other. The Office, however, specifically rejected this argument, finding, to the contrary, that extracting an email address inherently includes sending an email as a mere obvious variant thereof. The Office has therefore found step c. not material.

SUMMARY

The DECISION ON APPEAL (30 Sept 2004) relies on factual assumptions which are directly contradicted by the agency's prior administrative fact findings. MCGOVERN fails to include each claim element, and MCGOVERN must be withdrawn as a reference because the Office has previously concluded that Applicant antedates it.

Respectfully submitted,

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23 November 2004

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